

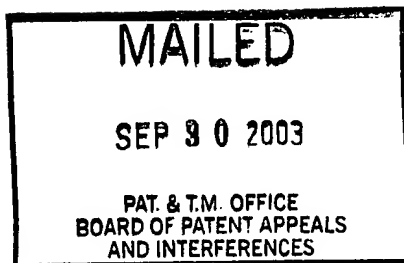
THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

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Paper No. 203

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



DAVID L. FOSNAUGH,

Junior Party,¹

v.

DELNO C. ABNET,

Senior Party.²

Patent Interference No. 103,019

HEARING: April 17, 2002

URYNOWICZ, PATE, and MARTIN, *Administrative Patent Judges.*

PATE, *Administrative Patent Judge.*

¹ Application 07/699,479, filed May 13, 1991.

² Application 07/697,444, filed May 9, 1991.

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FINAL DECISION UNDER 37 CFR § 1.658(a)

This is a final decision in Interference No. 103,019. The junior party inventor is David L. Fosnaugh. The senior party inventor is Delno C. Abnet. The junior party application is assigned to Franklin Co., Inc., the real party in interest of the junior party. The senior party application is assigned to L.H. Carbide Co., the real party in interest of the senior party.³

The subject matter of the interference concerns stamping stator plates for use in electric motors. FR-178, ¶8.⁴ The metal stator plates are formed by subjecting planar strips of stock material to consecutive stamping or punching operations. FR-178, ¶9.

The count reads as follows:

Count 1

Apparatus for shaping a series of discs in a metal strip, each pair of adjacent discs in the strip being connected,

³ The assignees will hereinafter be referred to as Franklin and Carbide, respectively.

⁴ In this opinion, the Fosnaugh record, brief, reply brief, and exhibits are abbreviated FR, FB, FRB, and FX- followed by the appropriate page or exhibit number. Likewise the Abnet record, brief and exhibits are abbreviated AR, AB, and AX- followed by the appropriate page or exhibit number.

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and the geometric centers between adjacent discs being separated by center-to-center distances, said apparatus comprising a progressive die having a succession of adjacent stations located along an imaginary center line, said geometric centers being located substantially on said center line, said adjacent stations having center-to-center distances which are fixed, and means for maintaining accurate progression of said discs through said stations despite variations in said center-to-center distances of said adjacent discs while maintaining said geometric centers substantially on said center line, said means for maintaining comprising slot punch means for cutting a plurality of slots which form a plurality of narrow bridges connecting said adjacent discs, said bridges being sufficiently narrow to be deformable to correct for said variations, and pilot means at a station adjacent said slot punch means for engaging and accurately locating a disc while said slot punch means are cutting said slots.

Claims of the parties that correspond to the count are:

Fosnaugh: Claims 13, 16, 22, 28, 29, 47, 48, 55, 56

Abnet: Claims 1-22, 27

The parties have a long history of litigation with respect to issues surrounding the subject matter involved in this interference. Prior to the interference, Franklin sued Carbide in the United States District Court for the Northern District of Indiana, Fort Wayne Division for misappropriation of technology relating to progressive stamping. During the course of discovery, Carbide was apprised of the Fosnaugh application and copied the Fosnaugh claims into its own pending application. Since the Abnet application was the first application filed,

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Abnet, by virtue of the copied claims, is senior party in this interference by four days.

Issues for Consideration

The following issues are raised by the respective parties:

Fosnaugh:

- a) priority of invention,
- b) patentability of Abnet claims 8-12, 18-22 and 27 under 35 U.S.C. § 112, first paragraph, written description,
- c) patentability of Abnet claims 1-22 under 35 U.S.C. §§ 102(b) or 103,
- d) patentability under 35 U.S.C. § 112, second paragraph, of Abnet claims 5-12, 14-16, 20-22, and 27,
- e) patentability of claims 10-12 of Abnet under 35 U.S.C. § 112, first paragraph, written description,
- f) patentability of all claims of Abnet designated as corresponding under 35 U.S.C. § 112, first paragraph, for failing to disclose the best mode, and
- g) a motion to suppress certain evidence,

Abnet:

- a) priority of invention,
- b) patentability of Abnet claims 8-12 and 18-22 under 35 U.S.C. § 112, first paragraph, written description,
- c) patentability under 35 U.S.C. § 112, second paragraph of Abnet claims 5-12, 14-16, 20-22, and 27,

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d) patentability of Abnet claims 1-22 under 35 U.S.C. §§ 102(b) or 103,

e) patentability of Abnet claims 10-12 under 35 U.S.C. § 112, first paragraph, written description,

f) patentability of all of Abnet's claims designated as corresponding under 35 U.S.C. § 112, first paragraph, best mode, and

g) a motion to suppress certain evidence.

We note that Fosnaugh has expressly withdrawn consideration of Fosnaugh preliminary motion 5 alleging inequitable conduct.

Fosnaugh has also expressly withdrawn consideration of Fosnaugh motion 7, a motion for judgment under 35 U.S.C. § 102(f).

Additionally, other motions decided by the Administrative Patent Judge (APJ) in favor of moving party Fosnaugh in the Motions Decision, Paper No. 120, **viz.** Item H. to redefine the interference by amending and adding claims, Item I. to designate claims as not corresponding to the count, Item P. to enter an Information Disclosure Statement, and Item R. to take testimony and for permission to use testimony adduced in another proceeding, are not challenged by the senior party. These decisions will not be further considered.

Motions to Suppress Evidence

We note as an initial matter the parties' citation of **Suh v. Hoefle**, 23 USPQ2d 1321, 1329 (Bd. Pat. App. & Int. 1991) (evidence is ordinarily not stricken for alleged irrelevance which goes only to the weight to be accorded that evidence and does not constitute a basis for striking) **citing Halbert v. Schuurs**, 220 USPQ 558, 562 (Bd. Pat. Int. 1983); **Crimmins v. Reid**, 180 USPQ 462, 463 (Bd. Pat. Int. 1973); **Davidson v. Carpenter**, 123 USPQ 171, 175 (Bd. Pat. Int. 1959). While **Suh** was decided after the 1985 rulemaking establishing 37 CFR § 1.601 **et seq.**, it does not reflect a reliance on FED. R. EVID. as mandated by those new rules. Accordingly, we decline to follow that line of cases and will suppress evidence under FED. R. EVID. 401 if it is clearly irrelevant.

We note that the Fosnaugh motion is replete with requests to suppress Abnet evidence on the grounds of irrelevance. Most of these requests are couched in the language that the count does not recite such a method or apparatus, that ideas and conversation of Abnet are irrelevant to the subject matter of the interference, or that background material on

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Carbide is irrelevant to the issues in this interference. We disagree. FED. R. EVID. 401 states that "Relevant evidence" means evidence having any tendency to make the existence of any fact that is of consequence to the determination of the action more probable or less probable than it would be without the evidence.

The background of the inventors, the circumstances surrounding the conception of the invention, the identity and function of the various witnesses that testify, the practices and procedures of the corporations the inventors worked for, and if these practices constitute an elaborate program of research, experimentation, or design of parts can all be relevant to the circumstances surrounding conception and reduction to practice.

While relevance is decided on an issue-by-issue basis, relative experience of the parties in the field at issue can be an important factor in an interference. **See Price v. Symsek**, 988 F.2d 1187, 1196 n.4, 26 USPQ2d 1031, 1038 n.4 (Fed. Cir. 1993). **See also Fersing v. Fast**, 121 F.2d 531, 537, 50 USPQ 112, 118 (CCPA 1941) (of the two parties, one party was more likely to have invented based on prior applications and patents, wide experience in development work, and recognized standing in

field). Likewise, the evidence relating to the assignee Carbide can establish the existence of orderly program of research or can indicate the routine pathways by which knowledge of ongoing research was disseminated throughout the assignee. *See Berges v. Gottstein*, 618 F.2d 771, 775, 205 USPQ 691, 695 (CCPA 1980) (evidence sets forth a highly organized procedure routinely practiced within assignee; equally relevant to the issue of corroboration of an actual reduction to practice are the routine pathways by which knowledge of ongoing research was disseminated throughout the research team). *See also Lacotte v. Thomas*, 758 F.2d 611, 613, 225 USPQ 633, 634 (Fed. Cir. 1985).

With respect to the evidence challenged as not corroborated, the issue of corroboration is an issue distinct and separate from that of admissibility, and we will not exclude evidence merely because it is said to be uncorroborated and therefore incompetent. *See Halbert*, 220 USPQ at 561. *Cf. Mattor v. Coolegem*, 530 F.2d 1391, 1394-95, 189 USPQ 201, 203 (CCPA 1976) where the Court stated:

The evidence necessary for corroboration is determined by a rule of reason [citation omitted]. Corroboration is not a ritual but a method for determining the veracity of the testimony. An inventor's testimony is

evidence, its weight a function of his credibility. One method of establishing credibility is by a corroborating witness, but it is not the only method.

Likewise, conclusory statements, while lacking a sufficient factual basis to be probative, are not inadmissible as such, since this issue is separate and distinct from an admissibility issue. Evidence will not be suppressed merely because it is said to be conclusory. However, conclusory evidence is entitled to be given little or no weight. *In re Lindner*, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972) ("[M]ere conclusory statements in the specification . . . are entitled to little weight.").

Finally, the mere statement that testimony of a witness lacks foundation without a particular and specific explanation as to what foundation is alleged to be lacking will not be suppressed.

The specific holdings in response to the paragraph-by-paragraph itemization in the respective motions to suppress are contained in the appendix to this decision.

Construction of the Count

Before turning to the parties' respective cases for priority of invention, we turn to the issue of the construction

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of the count in this interference. The pivotal issue of Count interpretation was addressed as follows in **Genentech, Inc. v. Chiron Corp.**, 112 F.3d 495, 500, 42 USPQ2d 1608, 1612 (Fed. Cir. 1997):

[T]he proper construction of the count . . . is a question of law. **DeGeorge v. Bernier**, 768 F.2d 1318, 1321, 226 USPQ 758, 760 (Fed. Cir. 1985). To construe the count we must look at the language as a whole and consider the grammatical structure and syntax. **Credle v. Bond**, 25 F.3d 1566, 1571, 30 USPQ2d 1911, 1915 (Fed. Cir. 1994).

In the absence of ambiguity, it is fundamental that the language of a count should be given the broadest reasonable interpretation it will support and should not be given a contrived, artificial, or narrow interpretation which fails to apply the language of the count in its most obvious sense. Only when counts are ambiguous may resort be had to the application where the counts originated, and this court does not look to the specification to determine whether there is an ambiguity.

In re Baxter, 656 F.2d 679, 686, 210 USPQ 795, 802 (CCPA 1981) (citations omitted).

With respect to the count elements "means for maintaining accurate progression of said discs" and "pilot means for . . . engaging and accurately locating a disc while said

slot punch means are cutting said slots," while we interpret both limitations broadly, we note that the means for maintaining accurate progression is recited as slot punch means. Thus, only structure comprising a slot punch means satisfies this element of the count. On the other hand, any structure that is present in the parties' priority proofs that performs the recited function of piloting the discs of the strip as they move through the slot punching station will satisfy this second means-plus-function limitation of the count.

We acknowledge the Fosnaugh argument that Abnet has stated that Fosnaugh is the inventor of the straddle pilots. However, as we have construed the count, any piloting means would satisfy this limitation. The count, as opposed to Fosnaugh's claims, does not require the specific piloting means--the straddle pilots--disclosed by Fosnaugh. It is only in instances of count ambiguity that counts are construed in light of disclosure. Neither party has established that the count in issue is ambiguous.

Priority

As the junior party in an interference between co-pending applications, junior party Fosnaugh bears the burden of proving priority, by a preponderance of the evidence. **See Cooper v. Goldfarb**, 154 F.3d 1321, 1326, 47 USPQ2d 1896, 1900 (Fed. Cir. 1998) (**quoting Scott v. Finney**, 34 F.3d 1058, 1061, 32 USPQ2d 1115, 1117 (Fed. Cir. 1994)). Priority, conception, and reduction to practice are questions of law which are based on subsidiary factual findings. **Cooper**, 154 F.3d at 1327, 47 USPQ2d at 1901.

Conception has been defined as the formation, in the mind of the inventor, of a definite and permanent idea of the complete and operative invention. **Coleman v. Dines**, 754 F.2d 353, 359, 224 USPQ 857, 862 (Fed. Cir. 1985) (**quoting Gunter v. Stream**, 573 F.2d 77, 80, 197 USPQ 482, 484 (CCPA 1978)).

Conception is complete when one of ordinary skill in the art could construct the apparatus without unduly extensive research or experimentation. **Sewell v. Walters**, 21 F.3d 411, 416, 30 USPQ2d 1356, 1359 (Fed. Cir. 1994). **See Summers v. Vogel**, 332 F.2d 810, 816, 141 USPQ 816, 820 (CCPA 1964); **In re Tansel**, 253 F.2d 241, 243, 117 USPQ 188, 189 (CCPA 1958).

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In order to establish an actual reduction to practice, the inventor must prove that: (1) he constructed an embodiment or performed a process that met all the limitations of the interference count; and (2) he determined that the invention would work for its intended purpose. **Cooper**, 154 F.3d at 1327, 47 USPQ2d at 1901.

Finally, conception and reduction to practice must be corroborated in point of time. An inventor must provide independent corroborating evidence in addition to his own statements and documents. **Hahn v. Wong**, 892 F.2d 1028, 1032, 13 USPQ2d 1313, 1317 (Fed. Cir. 1989); **Lacotte v. Thomas**, 758 F.2d at 613, 225 USPQ at 634. Such evidence "may consist of testimony of a witness, other than an inventor, to the actual reduction to practice or it may consist of evidence of surrounding facts and circumstances independent of information received from the inventor." **Hahn**, 892 F.2d at 1032-33, 13 USPQ2d at 1317; **Reese v. Hurst**, 661 F.2d 1222, 1225, 211 USPQ 936, 940 (CCPA 1981). A rule of reason applies to determine whether the inventor's testimony has been sufficiently corroborated. **Price**, 988 F.2d at 1194-95, 26 USPQ2d at 1036-37.

The "rule of reason" involves an examination, analysis and evaluation of the record as a whole to the end that a reasoned determination as to the credibility of the inventor's story may be reached. **Berges**, 618 F.2d at 776, 205 USPQ at 695; **Mann v. Werner**, 347 F.2d 636, 640, 146 USPQ 199, 202 (CCPA 1965). There is no single formula that must be followed in proving corroboration. Whether an actual reduction to practice has been corroborated must be decided on the facts of each particular case. **Berges**, 618 F.2d at 776, 205 USPQ at 695. Nonetheless, adoption of the "rule of reason" has not dispensed with the requirement that corroborative evidence must not depend solely from the inventor himself but must be independent of information received from the inventor. **Coleman**, 754 F.2d at 360, 224 USPQ at 862; **Reese**, 661 F.2d at 1225, 211 USPQ at 940; **Mikus v. Wachtel**, 542 F.2d 1157, 1159, 191 USPQ 571, 573 (CCPA 1976).

It is bedrock interference law that conception and reduction to practice may be proved by oral testimony alone. Even in those cases where the burden of proof must be met by a higher standard than a mere "preponderance," the burden can be

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carried by oral testimony alone. *Mfrs. Sys., Inc. v. ADM Indus., Inc.*, 198 USPQ 223, 234-35, not otherwise reported (N.D. Ind. 1978), *aff'd*, 206 USPQ 879 (7th Cir. Ind.); *cert. denied*, 442 U.S. 918 (1979), and the appellate court decisions there cited.

In *Lustig v. Legat*, 154 F.2d 680, 682, 69 USPQ 345, 348 (CCPA 1946), the predecessor to the Federal Circuit held:

It is too well settled in patent law to require extended discussion or citation of authority in support thereof that one may prove his priority of invention by oral testimony alone. It is true the courts scrutinize such testimony with care because of the possibility of fraud, mistake or bad memory bringing about improper results, but no court, to our knowledge, has ever held that one cannot establish priority by oral proof, and it very often occurs that priority is established in a most convincing way by oral proof, particularly where there is lack of inconsistency in the testimony of the witnesses and where there are related facts shown in the record, as are shown in the instant one, corroborating such testimony. Moreover, Legat's instant record contains considerable documentary evidence which supports and strengthens and gives convincing character to the testimony of Legat and his witnesses. [*Accord Sands v. Bonazoli*, 223 USPQ 450, 451 (Bd. Pat. Int. 1983).]

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On the other hand, priority proof based on oral testimony alone is subjected to greater scrutiny than proof with supporting physical or documentary evidence. In the recent case of *Juicy Whip, Inc. v. Orange Bang, Inc.*, 292 F.3d 728, 63 USPQ2d 1251 (Fed. Cir.), *cert. denied*, 537 U.S. 1019 (2002), the Federal Circuit again enumerated a list of factors for evaluating the credibility of oral statements. *See In re Reuter*, 670 F.2d 1015, 1021 & n.9, 210 USPQ 249, 255 & n.9 (CCPA 1981). Those factors include: (1) delay between event and trial, (2) interest of witness, (3) contradiction or impeachment, (4) corroboration, (5) witnesses' familiarity with details of alleged prior structure, (6) improbability of prior use considering state of the art, (7) impact of the invention on the industry, and (8) relationship between witness and alleged prior user. *Id.* (citing *E.I. du Pont de Nemours & Co. v. Berkley & Co.*, 620 F.2d 1247, 1261 n.20, 205 USPQ 1, 11 n.20 (8th Cir. 1980)). The court, especially in the context of proving priority of invention, has analyzed this corroboration requirement with a "rule of reason" analysis. *See Price*, 988 F.2d at 1195, 26 USPQ2d at 1037.

We note that the parties have furnished recreated sketches which are said to be copies of documents prepared to explain the alleged conception to others. These recreated sketches are not contemporaneous with the acts relied on in relation to the parties' priority cases and are not helpful in establishing the dates of conception or reduction to practice.

Fosnaugh Priority Case

The following represents our findings of fact with respect to the Fosnaugh case for priority of invention.

The junior party assignee is in the business of manufacturing electric motors. FR-178, ¶7. These electric motors have both rotors and stators that are manufactured by stacking together laminations or stamped out plates which are joined together to form the cores of the stators and rotors. FR-178, ¶8.

Prior to the time of the invention at issue, the art had recognized a problem existing in the process of stamping strips into lamination blanks to be secured together to form the rotors or stators of the electric motor. FR-179, ¶11; FR-261, ¶12. In this process, dimensional differences arose based partly

on the station center-to-center distances between adjacent lamination blanks being variable and the variations accumulating as the material was fed through the die. *Id.* FX-72 shows a die with successive die stations ST_1 , ST_2 , and ST_3 . The distances illustrated, $SCCD_1$ and $SCCD_2$, represent the distances between the die stations on the centerline of the die. FR-179, ¶11. An ideal stamping operation is wherein the center-to-center distances of the strip remain constant through the die.

In 1990, David Fosnaugh was an employee of Franklin Electric in Bluffton, Indiana. FX-5, ¶8. He was in charge of Franklin's stamping operations. *Id.* Fosnaugh states that in late 1988 or early 1989 he conceived the idea of adding a punch at an initial station of a lamination die to punch one long narrow slot transversely across the strip between successive lamination blanks or discs to form two narrow carriers or connecting bridges between each end of the slot and each outer edge of the scrolled strip. FR-180, ¶12. These scroll relief bridges at the ends of the slot would weaken the material between the lamination blanks and would allow the die to stretch or compress the bridges to adjust for any variability in the center-to-center distance between the lamination blanks. FR-261, ¶12.

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Fosnaugh states that he made a sketch of the original concept. The sketch has been discarded. Fosnaugh further states that he disclosed this initial concept to Mssrs. Denis Overdorf and Douglas D. Halberstadt. FR 180-81, ¶13.

Overdorf confirms that Fosnaugh disclosed to him in early 1989, the general concept of his idea to compensate for and solve the problem in the stamping process. FR-261, ¶12. Halberstadt states that the idea was disclosed to him in the spring or early summer of 1990. FR-246, ¶7.

Halberstadt stated that Fosnaugh disclosed to him the general concept of his idea to compensate for and solve the problem of maintaining center-to-center distances in the stamping process in the spring or early summer of 1990. FR-246, ¶7. None of the three witnesses states that the idea Fosnaugh disclosed at this time satisfied all limitations of the interference subject matter.

Fosnaugh further states that during 1989 he met with and disclosed to Delno C. Abnet his initial concept of one or both of the rounded or v-shaped slot end configurations. According to Fosnaugh, Abnet did not at this time state that he had previously conceived, thought of, seen or heard about this

initial concept. At this time, Abnet was an employee of Carbide. FR-181, ¶15.

According to Fosnaugh, while at home on Saturday, June 16, 1990, Fosnaugh again considered the problem Franklin had encountered with the Franklin die. The die then in use punched a narrow banding slot having v-shaped ends. The banding slot is used to contain a band that encircles the stacked plates and secures them together. FX-80 is a drawing depicting the banding slot then in use by Franklin. Fosnaugh conceived of punching two scroll relief slots transversely across the scrolled strip above and below the banding slots. FR-184, ¶23. Each of the scroll relief slots was to be formed with a v-shaped end that paralleled an adjacent end of the banding slot. This configuration formed a chevron-shaped scroll relief bridge between each scroll relief slot and the banding slot. *Id.* This narrow chevron-shaped scroll relief bridge allowed the adjacent lamination discs to move relative to each other, thereby correcting for the varying disc center-to-center distances. *Id.*

At the same time, Fosnaugh also conceived of incorporating four straddle pilots for accurately locating the lamination blank or disc while the scroll relief punches were cutting the scroll relief slots and while the pilot hole punches

were cutting the pilot holes. FR-185, ¶24. These pilot pins extend from the die face and have a flat side oriented toward the outer edge of the lamination disc for engaging and accurately locating the outer edge of the lamination disc while the scroll relief slots and pilot holes are being punched. *Id.*

Fosnaugh further states that he disclosed his invention to Claude McMillan at Franklin on June 18, 1990, and within a day or two thereafter to Halberstadt. FR-186, ¶27; FR-186, ¶28. Fosnaugh's disclosure took the form of showing McMillan and Halberstadt an enlarged sketch he had made by tracing a scrolled strip on a sheet of drawing paper and adding scroll relief slots and straddle pilots. FR-185, ¶26. This original sketch is not in evidence. *Id.* Fosnaugh also requested and received permission to disclose this invention to Abnet. FR-186, ¶27; FR-186, ¶28. Halberstadt's testimony is not specific as to dates, only stating "spring or summer 1990." FR-245-49. However, McMillan clearly states that Fosnaugh disclosed the invention to him on June 21, 1990. FR-236-37; FX-142. McMillan describes the scroll relief slots and bridges in ¶4 and straddle pilots in ¶6. Based on the corroborating testimony of McMillan, we accord Fosnaugh a corroborated conception of the subject matter of the count on June 21, 1990.

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Receiving permission from Halberstadt, Fosnaugh contacted Abnet and arranged for Abnet to travel to Franklin so that they could discuss installing the scroll relief feature on the Franklin die. Abnet traveled to Franklin on June 21, 1990. FR-186, ¶29. The two men met again on July 6, 1990. *Id.*

Fosnaugh states that he made an enlarged sketch of the invention as described and gave Abnet the sketch on either June 21, 1990 or July 6, 1990. FR-185, ¶26. After further discussions between Fosnaugh and Abnet, an outstanding Purchase Order (FX-78) between Franklin and Carbide was amended to provide for placing scroll relief features in the Franklin die that was to be rebuilt by Carbide. FR-191, ¶40; FX-89.

On July 27, 1990, the Franklin die was shipped to Carbide. On September 18, 1990, two Carbide employees returned to Franklin the Franklin die which had been rebuilt to include scroll relief. The die was immediately put on a 300 ton Minster lamination press. Next, Fosnaugh ordered bad steel strips that he had been saving to be run through a press in order to be straightened improving their flatness. Previously, this bad steel could not have been run through the lamination process, especially after it had been straightened, because the

variability of the center-to-center distances was too great. FR-194-95, ¶52. Using this bad steel amounted to operating the rebuilt die under the worst possible scenario. These bad steel scrolled strips were successfully run through the lamination press utilizing the rebuilt die which embodied the subject matter of the count. This is corroborated by Towns. FR-272, ¶8. Therefore, we credit Fosnaugh with a corroborated actual reduction to practice of the subject matter of the count as of September 18, 1990.

Abnet Priority Case

As we analyze the senior party's priority case, we are cognizant of the fact that the senior party must show all the elements of the count. We acknowledge the junior party's argument that it is possible to provide slots between adjacent blanks to correct for alignment problems, e.g., camber, wherein the slots would not be in proper position to correct for center-to-center distance discrepancies. For example, the Grotrian sketch FX-132; AX-51, although schematic, appears to show a large web or bridge in the center of the slots. We agree with the argument of the junior party in its Reply Brief at 37 that this

is similar to the prior art Archer configuration.⁵ Thus, it is an important part of the senior party's case to show that any slots or scroll relief proposed by Abnet be so located as to correct for longitudinal or center-to-center distance.

The following represents our factual findings underlying Abnet's priority case. Senior party inventor Abnet is an employee of senior party assignee L.H. Carbide. AR-17, ¶¶1,2. Carbide is in the business of designing and manufacturing progressive lamination dies. AR-18, ¶11. Abnet states that since the early 1980's he had been aware of a problem with running scroll material in progressive dies. He states that these problems include camber and stress when these materials are run in a progressive die. AR-19, ¶14. Abnet states that in about 1986 or 1987 he came up with the idea of weakening the material which interconnects the laminations in a strip of scroll material. AR-19, ¶15. Abnet states that he discussed the idea with Duane Schele. AR-20, ¶15.

⁵ This can be contrasted to the situation in the junior party's priority case in which it is acknowledged by both parties that the species invented by Fosnaugh, that of chevron-shaped bridges, did allow for the count limitation of correcting center-to-center distances. See AR-15, ¶20, for example.

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Abnet further states that in the spring of 1989 he came up with the idea of adding punches to a lamination die in order to cut slots in the scroll material between adjacent laminations in an early station of the lamination die. AR-20, ¶16.

According to Abnet, the piloting system located at one or more stations adjacent the slot punches would engage and accurately locate the laminations of the scroll material while the slot punches cut the slots. *Id.* Abnet states that he discussed his idea with Ron Grotrian, another Carbide employee in the spring of 1989. *Id.*

One Carbide customer was General Electric (GE) located in Springfield, Missouri. In 1989, GE had installed a new tandem interlock progressive die manufactured by Carbide at its electric motor plant in Springfield. AR-20, ¶¶18,19,20; AX-9, ¶7. However, because of variable center-to-center distances in the stock material as it progressed through the die, the lamina failed to interlock when stacked in the choke location of the dies. Consequently, GE could not produce a high number of interlocked stacks on a consistent basis. AR-20, §§19,20; AX-9, ¶7.

Carbide employee Ron Grotrian was able to improve the die's performance by careful adjustment. The adjustments did not solve the alignment problem, however. AR-21-22, ¶21; AX-9, ¶8. In order to address this problem, Abnet visited GE in August 1989. According to Abnet, he told a GE employee, James B. Duff, about his scroll relief idea. Abnet states he sketched his scroll relief idea on a strip of scroll material placed on a table. The scroll material has been discarded. AR-22, ¶¶ 24, 25; AX-9, ¶¶ 11, 12.

Duff corroborates the meetings with Abnet in August 1989. Unfortunately, Duff's description of the subject matter is conclusory. AX-9, ¶¶ 14, 15. Duff states that he has read and understood the count which is set out in his declaration. Then he states that Abnet's idea included every limitation of the count. This is a legal conclusion on the part of Duff. It is for the witness to recite facts. It is for us to make the legal conclusion about whether Abnet's invention is within the scope of the count.⁶ For example, it is unclear to us exactly what type

⁶ However, conclusory evidence is entitled to be given little or no weight. *Lindner*, 457 F.2d at 508, 173 USPQ at 358 ("[M]ere conclusory statements . . . are entitled to little weight.").

of piloting mechanism Abnet disclosed to Duff, the location of such a piloting mechanism, and thus whether it was within the scope of the count in interference. Duff is notably vague about any pilot means. Duff states that Abnet's idea required "some form of pilot means" ⁷ AX-9, ¶11. We note that the non-contemporaneous sketch AX-38 drawn as Abnet's recollection of the sketch on the scroll material does not appear to show a pilot means. The burden is on the senior party to show that each element of the count was disclosed to corroborating witness Duff. The burden is also on the senior party to provide corroboration of each element of the count, if it undertakes to establish a priority date before its effective filing date. We do acknowledge, however, that Duff states that it was his understanding that the Abnet idea was directed at easing the problems caused by center-to-center distance variation. AX-9, ¶13.

Another GE employee, Elza Campbell, is relied upon to corroborate Abnet's conception. Campbell states that he was

⁷ While we have construed the count broadly so that any pilot means that provides the recited function will be held to satisfy the count for priority purposes, in our view Abnet must have had a definite pilot means in mind to have a conception of the subject matter of the count.

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present when Grotrian attempted to address the alignment problem. AR-13, ¶12. For Campbell, the problem that GE was experiencing was related to alignment--the relief of camber. He states this in two places. AR-12, ¶11, AR-13, ¶12. Nothing in paragraph 13 or 14 of the Campbell declaration would convince us otherwise. The balance of the Campbell declaration is after the reduction to practice at Franklin and does not establish an Abnet conception.

Abnet further relies on his trip report, AX-39, reporting on the results of his trip to GE. His trip report contains the following sentence:

We discussed adding relief punches in the die to allow the pilots to more accurately position the part in the interlock and blank stations.

This one sentence description does not contain all elements of the count in interference and cannot provide, by a preponderance of the evidence, proof of Abnet's conception of the subject matter of the count. It is silent with respect to the count element respecting center-to-center distance correction.

Abnet further relies on Ron Grotrian, a Carbide employee, as a corroborator of the 1989 conception. Grotrian states that he was familiar with the problems in GE's operation

and names these problems as camber, snaking, and stress, whereby the material would not lay flat. AR-93, ¶6. Grotrian states that Abnet disclosed to him in September 1989, a concept he had come up with. The concept consisted of punching a plurality of slots in strips of laminate material, which concept Abnet referred to as scroll relief. Grotrian states that Abnet sketched the idea for him. AR-93, ¶7. At AR-94, ¶10, the only mention of the elements of the count are with reference to AX-51 and AX-52, two non-contemporaneous sketches. This evidence is entitled to relatively little weight, in establishing what Grotrian understood Abnet's invention to be in 1989. At AR-41, ¶13, Grotrian also describes Abnet's invention. In this paragraph, Grotrian does not mention center-to-center distances, slot punches, any specific pilot means, or the location of a pilot means.

Finally, at AR-42, ¶18, Grotrian states that he proposed scroll relief to GE in January 1990. Grotrian discusses exactly what he proposed to GE in terms of a non-contemporaneous sketch AX-52. Such a non-contemporaneous sketch, produced well after the critical date, is not documentary evidence that can be accorded substantial weight in establishing the elements of Grotrian's proposal to GE in January 1990. We are unable to

credit Abnet with a conception based on this evidence from Grotrian.

We have reviewed the evidence from each of Abnet's corroborating witnesses. But another question remains. Using a "rule of reason" analysis, does the totality of the direct evidence and circumstantial evidence, considered as a whole, establish by a preponderance of the evidence that Abnet conceived the subject matter of the count prior to meeting with Fosnaugh in June 1990? In our view, it does not.

First of all, the oral testimony and Abnet's trip diary AX-39 do not unambiguously establish that Abnet's invention was directed to longitudinal or center-to-center distance correction and not just correction for the problem of camber. As we have noted, the corroborating witnesses are all over the map with regard to this issue. For example, Duff affirmatively states he understood the invention to be concerned with center-to-center distance correction. However, Campbell appears to unequivocally refer to camber correction or alignment in two locations in his declaration. Thus, the GE corroborators have given conflicting testimony. When Grotrian describes the problem that GE was having he states the problem as camber, snaking, and stress

whereby the material would not lie flat. This is not a description of a problem that is the central concern of the subject matter of the interference. Even as late as the filing date of the Abnet involved application, it is not clear whether Abnet conveys possession of the subject matter of correcting center-to-center distances. See, for example, other portions of this opinion. Accordingly, it is difficult for us to conclude that all the evidence as a whole under a rule of reason analysis establishes a conception by Abnet prior to the meeting with Fosnaugh in June 1990.

Secondly, Abnet's conception claim is based on oral testimony. As we noted above, while oral testimony alone may prove priority of invention, here the oral testimony is not unambiguous. Therefore, it is not of the character or clarity necessary to establish an earlier conception date by a preponderance of the evidence.

Finally, another factor gives us pause when accessing the senior party's priority timeline. According to the parties, the problem the invention is intended to solve was a long-standing problem that many persons in the art were aware of. It is the senior party's testimony that Abnet discovered a solution

to this long-standing problem in 1989. Yet no one was interested in the solution. Apparently, Carbide did not disclose the solution to other customers besides GE, and GE was uninterested at this time. If we contrast this to the junior party conception, once the solution to the problem was conceived, steps were immediately taken to incorporate these features into a die for testing and production. If the senior party conceived of the invention in the time frame as alleged, it is not clear why there are no actions on the part of the senior party to utilize the invention to solve this long-standing problem in the industry.

Although we have concluded that Abnet has not shown a corroborated conception of the invention prior to June 1990, the date of the Fosnaugh conception, for completeness we will make findings and conclusion of law respecting communication, diligence and reduction to practice.

Abnet argues that he communicated the invention to Fosnaugh. AB-96-99. According to Abnet, in the spring of 1990, Abnet met with Fosnaugh. Abnet states that they discussed scroll alignment problems, and that Abnet proposed using his scroll relief idea in the Franklin die to solve the alignment problem. This alleged conversation is supported by no corroborating

evidence, and the testimony from Abnet does not establish a communication of a conception to Fosnaugh by a preponderance of the evidence.⁸ Thus, even if we assume that Abnet has proved a prior conception, which he has not, Abnet has not shown communication, an essential part of an originality contest. Abnet fails to make out a case of derivation by a preponderance of the evidence.

With respect to diligence,

one who is first to conceive but last to reduce to practice is entitled to priority only on a showing of reasonable diligence extending from a time prior to the other party's conception to its own reduction to practice. 35 U.S.C. § 102(g) (2000); **Marhurkar v. C.R. Bard, Inc.**, 79 F.3d 1572, 1578, 38 USPQ2d 1288, 1291 (Fed. Cir. 1996).

In re Jolley, 308 F.2d 1317, 1326, 64 USPQ2d 1901, 1908 (Fed. Cir. 2002).

Assuming an Abnet conception prior to the conception of Fosnaugh, an Abnet conception which we have not credited, Abnet must show reasonably continuous activity from just prior to the Fosnaugh conception on June 21, 1990. Following Abnet's timeline,

⁸ Fosnaugh testifies about the meeting. He cannot provide corroboration, inasmuch as he states he disclosed his idea to Abnet.

however, Abnet alleges no activity just prior to Fosnaugh's entry into the field. Indeed, the only activity alleged in 1990 with respect to the subject matter of the count on the part of Abnet is the visit by Grotrian to GE in January and the spring meeting between Fosnaugh and Abnet. Thus, even if Abnet had conceived of the invention in the time frame claimed, his priority case would fail based on a lack of diligence.

As noted in Fosnaugh's priority case, there is little doubt that the subject matter of the count was reduced to practice on September 18, 1990. Both parties agree on this conclusion of law. Abnet argues that this reduction to practice inures to his benefit.

"Inurement involves a claim by an inventor that, as a matter of law, the acts of another person should accrue to the benefit of the inventor." *Cooper*, 154 F.3d at 1331, 47 USPQ2d at 1904. Inurement is a question of law. *Genentech, Inc. v. Chiron Corp.*, 220 F.3d 1345, 1351, 55 USPQ2d 1636, 1642 (Fed. Cir. 2000). As to whether Abnet can obtain the benefit of the reduction to practice at Franklin in September 1990, in the most recent cases, the Federal Circuit has recognized three requirements that must be met before a non-inventor's work on an

invention can inure to the benefit of the inventor. First, the inventor must have conceived of the invention. Second, the inventor must have had an expectation that the embodiment tested would work for the intended purpose of the invention. Third, the inventor must have submitted the embodiment for testing for the intended purpose of the invention. **Genentech**, 220 F.3d at 1354, 55 USPQ2d at 1643.

We are of the view that Abnet's claim of reduction to practice based on an inurement theory fails on all three factors recited in **Genentech**. First, as noted above, Abnet has not shown by a preponderance of the evidence that he conceived of the invention before Fosnaugh. Second, under the facts of this case we do not believe that Abnet as the inventor had a reasonable expectation that the invention would work for its intended purpose. Franklin paid to have the scroll relief feature put into a very expensive die on which Franklin's motor production depended. Thus, Franklin has demonstrated that they had a reasonable expectation that the die would work for its intended purpose.

Carbide, on the other hand, was entirely willing for Franklin to take the complete risk with respect to the scroll

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relief feature. In this regard, we credit the argument by Fosnaugh that Carbide did not attempt to reduce the invention to practice on its own. Carbide relies on the allegedly high cost of building a die to justify a seventeen month delay from the alleged Abnet conception to the Carbide installation of the modified GE die between January 30 and February 1, 1991. This does not evidence a reasonable expectation that the invention would work for its intended purpose.

Finally, we are not convinced that it can be said that Abnet submitted the scroll relief die to Franklin for testing. Franklin ordered the die modifications from Carbide. We cannot divine any agreement express or implied that Carbide was submitting an invention to Franklin for testing. Franklin was operating on the clear understanding that its employee Fosnaugh had invented scroll relief, and it ordered the die modified. In view of these three factors, it is our view that the reduction to practice at Franklin did not inure to Carbide.

However, in our view, there is sufficient evidence of record to accord Abnet a reduction to practice of the invention at GE on January 30 to February 1, 1991. Accordingly, Fosnaugh stands as a junior party that has antedated the effective filing

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date of the senior party by showing a reduction to practice
therebefore. On the other hand, Abnet has not antedated the
Fosnaugh actual reduction to practice by a prior or simultaneous
reduction to practice or by prior conception with due diligence
from just prior to the junior party conception up to Abnet's own
reduction to practice. The junior party has won the priority
contest. Judgment will be entered for the junior party based on
the ground of priority of invention.

Review of Motion Decisions

Standard of Review

On March 16, 1999, the Patent and Trademark Office
issued an interim rule change of patent interference rule 37 CFR
§ 1.655(a). 64 FR 12900. The rule deals with the application of
the abuse of discretion standard by a merits panel when
considering an interlocutory order entered by a single APJ acting
in an interlocutory capacity. The rule has been changed to
emphasize that a panel of the Board will resolve the merits of an
interference as a panel without deference to any interlocutory
order. Panels will, however, continue to apply the abuse of
discretion standard but only with respect to procedural matters

decided by the single APJ acting in an interlocutory capacity. Accordingly, we consider the substantive issues dealt with by the APJ in his interlocutory capacity and raised by the parties in their briefs giving them *de novo* consideration in this decision.

Construction of Abnet Claims

First, we turn to the construction of Abnet claims designated as corresponding to the count. We are in agreement with the parties that claims in an interference are given the broadest reasonable interpretation consistent with the disclosure. *In re Van Geuns*, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993); *Behr v. Talbott*, 27 USPQ2d 1401, 1404 (Bd. Pat. App. & Int. 1992); *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). Moreover, limitations are not to be read into the claims from the specification. *Id.*

Fosnaugh raises the issues of the construction of Abnet's claims at FRB-66. It is apparent that the APJ construed the limitation of Abnet independent claims 1 and 8, wherein it is said that "adjacent blanks may be moved toward and away from one another to effect alignment" as calling for movement only in the

longitudinal direction of the strip or such that the center-to-center distances between the blanks are reduced when the blanks move toward one another, and the center-to-center distances of the adjacent blanks are increased when the blanks move away from one another.. We are of the view that this is the correct construction of claims 1 and 8.

With respect to claim 3, the APJ construed the language of "providing for compression and stretching of the material between at least one pair of successive lamination blanks" as covering three possibilities. In view of the fact that the claim does not state a temporal limitation as to when the compression and stretching shall occur, the claim was construed as directed to the situation where the material joining the blank is both compressed and stretched at the same time or entirely stretched and then entirely compressed at serial stations or entirely compressed and then entirely stretched at serial stations. The APJ was apparently of the impression that this was the broadest reasonable interpretation of the compression and stretching language. We concur.

The direction of elongation limitation of claim 6 and claim 10 is relatively straightforward. It clearly refers to a

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change in the center-to-center distance between adjacent blanks. Claim 10 additionally requires linear movement.

The APJ stated that claim 13 was a result oriented claim that merely requires that the blanks align. We agree with this construction of claim 13.

We have considered anew the construction of the Abnet independent claims as to the language of the direction of movement of the blanks, and we find ourselves in agreement with the express or implicit constructions advanced by the APJ in the decision on motions.

Patentability of Abnet Claims Under 35 U.S.C. § 112 (first paragraph) Descriptive Support (Fosnaugh Motion A)

Under 37 CFR 1.633(a), a preliminary motion was filed by Fosnaugh on the ground that claims 8-12, 18-22, and 27 of the Abnet involved application were unpatentable to Abnet based on the lack of written descriptive support under 35 U.S.C. § 112 (first paragraph). A merits panel of the Board decided this issue with respect to Abnet claims 8-12, 18-22 and 27. See Paper No. 120. Judgment will be entered against Abnet on the ground of unpatentability with respect to these claims.

Fosnaugh has renewed this motion with respect to "straddle pilots." In the previous merits panel decision, the issue was said to be moot based on the lack of descriptive support for other portions of Abnet claims.

Construction of Abnet Claim 27 "pilot means"

Initially, we note the presence in Abnet claim 27 of "means for" language, *viz.*, "means for maintaining accurate progression of the discs" and "pilot means for . . . engaging and accurately locating a disc while said slot punch means are cutting said slot." As the Federal Circuit stated in *Cole v. Kimberly-Clark Corp.*, 102 F.3d 524, 530-31, 41 USPQ2d 1001, 1006 (Fed. Cir. 1996), *cert. denied*, 522 U.S. 812 (1997):

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

35 U.S.C. § 112, ¶ 6 (1994). To invoke this statute, the alleged means-plus-function

claim element must not recite a definite structure which performs the described function. Patent drafters conventionally achieved this by using only the words "means for" followed by a recitation of the function performed. Merely because a named element of a patent claim is followed by the word "means," however, does not automatically make that element a "means-plus-function" element under 35 U.S.C. § 112, ¶ 6. **Laitram Corp. v. Rexnord, Inc.**, 939 F.2d 1533, 19 USPQ2d 1367 (Fed. Cir. 1991), cited in the dissenting opinion, creates no presumption to the contrary. The converse is also true; merely because an element does **not** include the word "means" does not automatically prevent that element from being construed as a means-plus-function element. **See, e.g., Raytheon Co. v. Roper Corp.**, 724 F.2d 951, 957, 220 USPQ 592, 597 (Fed. Cir. 1983) (construing functional language introduced by "so that" to be equivalent to "means for" claim language), **cert. denied**, 469 U.S. 835 [225 USPQ 232] (1984); 1162 O.G. 59, 59 (17 May 1994) (examination guidelines stating that the term "means" is not required to invoke § 112, ¶ 6). We decide on an element-by-element basis, based upon the patent and its prosecution history, whether § 112, ¶ 6 applies.

Turning to the first means recited in the claim, i.e., the "means for maintaining accurate progression," we note that the claim relates that this means comprises a "slot punch means." With respect to the slot punch means, as recited in the claim, we decline to invoke section 112, sixth paragraph, since the

structure of this element of the claim is actually recited in the element's name. The structure is that of a slot piercing punch. Inasmuch as the structure of the slot punching means is recited in the claim, and the claim states that the "means for maintaining accurate progression" is comprised of an element the structure of which is related in the claim, we find no reason to construe the "means for maintaining accurate progression" within the meaning of section 112, paragraph 6.

Turning to the pilot means, we note that this recitation is given in more functional language. The term "pilot" is functional in that it has a general definition of a mechanical structure used to center or locate cooperating mechanical parts. In this instance, it is our determination that section 112, sixth paragraph, is invoked and we turn to the specification to determine how this element is to be construed. In the Fosnaugh specification, we note that straddle pilots 52 are used to engage the angled sides of the lamination blank in cooperation with pilot pin 51 which engages center hole 42 at the station in which the slot piercing punch forms the slots 57 leaving the narrow width bridges 58 to 61. Accordingly, under section 112, sixth paragraph, we construe the pilot means to be

the straddle pilot pins 52 cooperating with the center pilot 51 and equivalents thereof.

With respect to the Abnet application, the construction of the element "pilot means" is satisfied by the disclosure of alignment holes 37-43 utilized at each station 2 through 5 for aligning the blank with the corresponding punch and die set. Fosnaugh seems to be under the misapprehension that Abnet must disclose straddle pilots in order to have descriptive support for this limitation of claim 27. Such is not the case. The jurisprudence is clear that for construction of a means-plus-function limitation we look to the Abnet specification.

We acknowledge testimony that alignment holes 37-43 could be used with structure other than pilot pins to satisfy the alignment needs at die stations 2-5. However, we interpret the limitation in light of the Abnet specification and the holes, whether engaged by pins or cooperating with a sensor of some sort, serve a "piloting" function giving that term its broadest reasonable interpretation. Thus, we are not of the view that Abnet lacks descriptive support for the piloting means limitation of claim 27.

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Patentability of Abnet Claims Under 35 U.S.C. § 112 (second paragraph) (Fosnaugh Motion B)

Under 37 CFR § 1.633(a), a preliminary motion was filed by Fosnaugh on the ground that Abnet claims 5-12, 14-16, 20-22, and 27 were not patentable to Abnet under 35 U.S.C. § 112 (second paragraph) as they do not particularly point out and distinctly claim the invention. In a Decision on Preliminary Motions, the APJ denied the motion in its entirety.

It is noted that Fosnaugh makes no new arguments or points to any error on the part of the APJ in the Fosnaugh opening brief. Although we have considered the matter anew, we are in agreement with the APJ. For completeness, we include remarks showing our agreement with the APJ.

With regard to the second paragraph requirement for "particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention," it has been stated that the "essence of that requirement is that the language of the claims must make it clear what subject matter they encompass." *In re Hammack*, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970). This has been frequently stated in a shortened form as a requirement that the claims set forth the "metes and

bounds" of their coverage. *See, merely for example, In re Venezia*, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976); *In re Goffe*, 526 F.2d 1393, 1397, 188 USPQ 131, 135 (CCPA 1975); *In re Watson*, 517 F.2d 465, 477, 186 USPQ 11, 20 (CCPA 1975); *In re Knowlton*, 481 F.2d 1357, 1366, 178 USPQ 486, 492 (CCPA 1973).

This requirement has usually been viewed from the perspective of a potential infringer, "so that they may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance." *Hammack*, 427 F.2d at 1382, 166 USPQ at 208.

We are in agreement with the APJ regarding Abnet claims 5, 7, and 14. Fosnaugh argues that these claims are indefinite due to the use of the term "the majority." In response to this argument, the APJ was of the view that this term merely defines a quantitative relationship, i.e., over half, and as such need not have an antecedent basis. Fosnaugh argues that it is unclear that removal of a simple majority of material will result in the invention being able to fulfill other limitations. While this is apparently a new argument on the part of Fosnaugh, it is not convincing. It is the independent claims that have

limitations directed to "providing for compression and stretching," "the step of weakening," or "said weakening step." The claims at issue do not state that a removal of a simple majority accounts for this. Otherwise, the independent claims would be incomplete themselves without the majority limitation. We agree with the APJ that the use of this term does not obscure the metes and bounds of Abnet's claimed invention.

Turning to claims 6, 7, 9-12, and 16, the arguments in the motion with respect to the term "the direction" clearly refer to "the direction of elongation of said strip." Here again, we are of the view that the APJ correctly determined that the claims were not indefinite under the purview of section 112, second paragraph.

Fosnaugh also argued in the motion that claims 8, 9, and 22 could not be understood inasmuch as the phrase "between adjacent lamination blanks" was found without antecedent basis. We are of the view that the APJ correctly held that these claims are not indefinite on this ground.

With respect to claims 20, 21, and 27, the APJ found that although the term "pilot hole" was not *ipsis verbis* found in the Abnet specification, one skilled in the art of progressive

stamping would understand the term as used in these claims. We agree with the APJ that this term does not render the claims indefinite.

The motion of unpatentability has been considered anew by the panel, and we find ourselves in agreement with the APJ that the Abnet claims are not indefinite under 35 U.S.C. § 112, second paragraph. The motion is DENIED in its entirety.

Patentability of Abnet Claims Under 35 U.S.C. §§ 102 and 103
(Fosnaugh Motion C)

Under 37 CFR 1.633(a), a preliminary motion was filed by Fosnaugh on the ground that Abnet claims 1-22 are not patentable over the prior art Archer⁹ patent under 35 U.S.C. §§ 102 and 103. In a Decision on Preliminary Motions, the APJ granted the Fosnaugh motion in part, holding that claims 3-5 and 18-21 are unpatentable over Archer under section 102 and that claims 9 and 13-17 are unpatentable under section 103 as unpatentable over Archer in view of Murch.¹⁰ Fosnaugh seeks review of the holding that claims 1, 2, 6-8, 10-12, and 22 are

⁹ U.S. Patent No. 3,107,566, hereinafter Archer.

¹⁰ U.S. Patent No. 1,992,962, hereinafter Murch.

not anticipated by Archer. FB-251. On the other hand, Abnet seeks review of the decision that claims 9 and 13-21 are unpatentable. AB-168. Apparently, Abnet concedes claims 3-5 are unpatentable. Judgment will be entered with respect to Abnet claims 3-5 on the ground of unpatentability.

The following represents our findings of fact with respect to the Archer disclosure. Archer discloses an apparatus and method for shaping a series of discs in an interconnected strip while maintaining proper alignment of the stock in a multiple step die. The disclosure of Archer is directed at solving a problem where the uncoiled stock material exhibits curvature called camber in this art. Col. 1, lines 20-37. Figure 1 is an exaggerated representation of camber in the stock material. The solution for Archer is to provide slots 14 in the stock which extend inwardly from the outer edge. These slots form a narrow neck 16 which allows the stock to flex or bend at the connecting necks. Col. 2, lines 11-12. It is our further finding that Archer does not teach or suggest longitudinal or center-to-center distance correction but only flexing or bending at the bridges to allow the angular aspect of the discs to adjust with respect to one another as the material is fed through the progressive die.

Based on these factual findings, we are in agreement with the APJ that Abnet independent claims 1, 8 and 10 are not unpatentable to Abnet over the cited prior art. Archer does not show the center-to-center distance correction which we have construed these claims to require.

Murch discloses the use of scrolled strips for reasons of economy in producing blanks. We are in agreement with the APJ that it would have been obvious to one of ordinary skill in this stamping art to use the scrolled material starting strips of Murch in the stamping process of Archer to save on materials as Murch suggests. Accordingly, reviewing the motion with respect to claims 9 and 13-17, we find ourselves in agreement with the APJ that these claims are unpatentable over the cited prior art.

Abnet also argues claims 18-21 are patentable over Archer. However, we are in agreement with the APJ that, broadly speaking, pilot hole 20 in neck 16 is an aperture that defines multiple bridges between a pair of lamination blanks. Note that each of these holes 20 is on one side of the centerline of the elongated strip. This disclosure of Archer anticipates claims 18-21.

Fosnaugh argues that Abnet cannot have it both ways. That is, Abnet's claims 1-22 cannot be held to be distinguishable over the prior art based on longitudinal correction for progression error when Abnet's application does not contain original description for longitudinal correction for progression error. FRB-66. Actually, Fosnaugh's argument is an apt description of what the APJ held in the motions decision. The Abnet claims held to be patentable over Archer or Archer and Murch were claims directed to longitudinal or center-to-center distance correction. In considering the rejection based on prior art, it is immaterial whether Abnet has support for such a limitation. Instead, the subject matter of the instant claims is compared to what the prior art reference discloses.

In summary, claims 1, 2, 6, 7, 8, 10-12, and 22 are patentable over the cited prior art. Claims 3-5, 9, and 13-21 are not patentable over Archer or Archer in view of Murch. Judgment will be entered against claims 3-5, 9 and 13-21 on the ground of patentability.

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Patentability of Abnet Claims Under 35 U.S.C. § 112 (first paragraph) Descriptive Support (Fosnaugh Motion D)

Under 37 CFR 1.633(a), a preliminary motion was filed by Fosnaugh on the ground that claims 10-12 of the Abnet involved application were unpatentable to Abnet based on the lack of written descriptive support under 35 U.S.C. § 112 (first paragraph). A merits panel of the Board decided this issue with respect to Abnet claims 8-12, 18-22 and 27. See Paper No. 120. Accordingly, judgment will be entered against Abnet on the ground of unpatentability with respect to claims 10-12 included in the prior decision.

Patentability of Abnet's Claims Under 35 U.S.C. § 112, (first paragraph), Best Mode (Fosnaugh Motion F)

Under 37 CFR § 1.633(a), junior party Fosnaugh brought a preliminary motion based on the ground that Abnet's application claims corresponding to the count in interference are unpatentable to Abnet under 35 U.S.C. § 112 (first paragraph) for failure to disclose the best mode for practicing the invention. The APJ did not decide this issue in the decision on preliminary motions. Instead, he permitted testimony to be taken on this issue.

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Determining whether a patent complies with the best mode requirement involves two underlying factual inquiries. First, it must be determined whether, at the time the patent application was filed, the inventor had a best mode of practicing the claimed invention. *Chemcast Corp. v. Arco Indus. Corp.*, 913 F.2d 923, 927-28, 16 USPQ2d 1033, 1036 (Fed. Cir. 1990). This inquiry is wholly subjective and addresses whether the inventor must disclose any facts in addition to those sufficient for enablement. *Id.* at 928, 16 USPQ2d at 1036. Second, if the inventor had a best mode of practicing the claimed invention, it must be determined whether the specification adequately disclosed what the inventor contemplated as the best mode so that those having ordinary skill in the art could practice it. *Id.* at 928, 16 USPQ2d at 1036-37. The latter question "is largely an objective inquiry that depends upon the scope of the claimed invention and the level of skill in the art." *Id.* at 928, 16 USPQ2d at 1037.

The following are our findings of fact with respect to the best mode issue. Fosnaugh argues that a notation on a letter (FX-22; AX-47) from Abnet's patent attorney to Abnet is a so-called smoking gun that establishes that Abnet, as inventor,

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omitted a mode of practicing the invention that was better than other modes disclosed in his application. FX-22 is a transmittal letter from the patent attorney Roger M. Rickert to Abnet.

Handwritten on the lower part of the letter is the notation,

Looks good, would we improve or should we
describe in detail what form the connecting
web of material should look like[?]

Following the notation are two sketches in schematic form of a chevron-shaped bridge and an apparently straight bridge with curved lead-ins and lead-outs. Underneath the schematic sketches is a handwritten notation, "allows for greater adjustment" with an arrow pointing to the chevron-shaped bridge.

Abnet testified that sometime after February 22, 1991, but before his patent application was filed, he wrote a note to Tom Neuenschwander on a letter he had received from patent attorney Rickert. AR-30, ¶50. AX-47 is a copy of the letter. At the time he wrote the hand-written notation on the letter, he believed that the chevron shape would perform better than the non-chevron shape. *Id.*

Abnet further testified that shortly after he wrote the note, but before the application was filed on May 9, 1991, he discussed the web or bridge shape with Neuenschwander. AR-31,

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¶51; AR-88, ¶17. Abnet states that they both came to a conclusion that there was no advantage to the chevron shape. According to the testimony, they considered several other shapes. FX-2B, at 11-13. They knew that regardless of the shape of the connecting webs, the webs needed to be strong enough to allow the material to be fed through the die, yet weak enough to permit alignment of the laminations at the individual stations. AR-31, ¶51. Since they concluded that the chevron shape had no advantage, they did not include it in the application. *Id.* Abnet further states that their theoretical prediction as to bridge shape has proven to be correct in subsequently built dies. AR-31, ¶54.

Neuenschwander confirmed that Carbide had not manufactured or tested any dies with other than chevron-shaped bridges prior to the May 9, 1991 filing date of the senior party involved application. AR-117.

Fosnaugh argues that this is clear evidence that Abnet had the subjective belief at the time the application was filed that chevron-shaped bridges were the best mode for practicing the claimed invention. Fosnaugh further argues that the chevron-shaped scroll relief bridges were the only mode known by Abnet

and Carbide to have been tested and known to have worked for the purpose of the claimed invention.

In our view, the notation on the letter is a clear request for a conversation on what to include in the application. Thus, it rings true to us that the Abnet-Neuenschwander conversation occurred on this topic after the letter was written and before the application was filed. Contrary to what Fosnaugh argues, however, we believe that the record clearly shows that while Abnet may have had a subjective impression that the chevron-shaped bridge was the best mode when the letter was notated, after a theoretical discussion with Neuenschwander, these two workers skilled in the art determined that other shapes would suffice. Accordingly, we hold that at the time the involved Abnet application was filed, Abnet did not have a subjective belief that chevron-shaped bridges were the only or even the best mode for practicing the claimed invention. Fosnaugh's argument regarding best mode fails under step one of the **Chemcast** test. Fosnaugh's 37 CFR § 1.633(a) motion of unpatentability on the ground of best mode under section 112 is **DENIED**.

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Appendix

Decision on Fosnaugh Motion to Suppress

Abnet declaration (AR-17-33)

¶11 not suppressed. Background material is relevant to issues in interference as explained in decision.

¶12 not suppressed. Background material not irrelevant.

¶15 not suppressed. Background material not irrelevant. Material not suppressed for lack of corroboration--corroboration is not an admissibility issue. Last sentence is suppressed as hearsay.

¶16 not suppressed. Evidence not suppressed for lack of corroboration.

¶19 not suppressed. It is unclear why Fosnaugh believes these dies are not within the personal knowledge of Abnet.

¶¶ 24-25 not suppressed. Shows state of mind of declarant. Witness can testify to what he believes to be true, i.e., what he assumes.

¶ 26 not suppressed. Sketch can come in for limited purpose. But in weighing evidence it cannot establish a date of its original creation.

¶¶27-28 not suppressed. Evidence is not suppressed for alleged lack of corroboration.

¶29 First sentence suppressed as hearsay.

¶30 not suppressed. The legal conclusion is allowed in but may be entitled to little weight.

¶31 not suppressed. Evidence not suppressed because other evidence conflicts therewith.

¶34 not suppressed. Claimed lack of foundation is not specific enough to grant the requested relief. Unclear why Fosnaugh thinks Abnet does not have personal knowledge of Franklin's die.

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¶38 Penultimate sentence suppressed. More prejudicial than probative.

¶¶39, 41, 44 and 45 not suppressed. Evidence not suppressed for alleged lack of corroboration.

¶48 not suppressed for alleged lack of foundation. Abnet certainly knows more about why Carbide employees went to Franklin than Fosnaugh.

¶51 not suppressed as speculative or outside personal knowledge of Abnet.

¶¶ 52, 53 not suppressed. Background material not irrelevant.

¶54 not suppressed. Based on personal knowledge of Abnet.

Declaration of Abnet (AX-7)

¶¶5 and 9 not suppressed. Evidence is not suppressed for alleged lack of corroboration. Conclusory evidence is admissible but may be entitled to little weight.

¶11 not suppressed. Unclear why not based on personal knowledge. The claim that this lacks foundation is so non-specific as to be not entitled to any relief.

¶13 not suppressed. Evidence is not suppressed for alleged lack of corroboration. The claim that this lacks foundation is so non-specific as to be not entitled to any relief. Conclusion they reached together not seen as hearsay.

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Declaration of Abnet at AR-84-89

¶¶ 5, 6 not suppressed as hearsay.

¶12 not suppressed. Not hearsay to the extent that it comes in to reflect what Abnet believes to be true.

¶14 not suppressed. Not hearsay to the extent that it comes in to reflect what Abnet believes to be true.

¶¶15, 16 not suppressed. Evidence is not suppressed for alleged lack of corroboration.

¶17 not suppressed. Not seen to be hearsay, speculation or lacking in proper foundation.

¶18 not suppressed. Not seen to be hearsay or lacking in proper foundation.

Declaration of Campbell at AR-9-16

¶8 not suppressed. Witness can testify to what he has not seen or heard of.

¶13 not suppressed. Unclear as to why Fosnaugh believes Campbell had no knowledge of trip.

¶14 not suppressed to the extent that it relates to what Campbell thought Abnet's idea was. Campbell's understanding of the invention may be different than what the invention actually is, i.e., what Abnet actually told Duff, which is hearsay.

¶15 not suppressed. Sketch does not purport to be a copy, so it is not subject to best evidence rule. Recreated sketch is neither evidence of content of original or evidence of date of original. It is admissible but has been accorded but little weight.

¶18 not suppressed. Describes Campbell's actions. Last sentence suppressed as hearsay.

¶20 not suppressed. Not irrelevant. Unclear why this is not within Campbell's personal knowledge.

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Campbell declaration at AR77-83

¶3 not suppressed. Witness can testify to what he has not seen or heard of.

¶¶8, 9 not suppressed. They concern action by others observed by Campbell. Sketch does not purport to be a copy, so it is not subject to best evidence rule. Recreated sketch is neither evidence of content of original or evidence of date of original. It is admissible but has been accorded but little weight.

¶10 not suppressed to the extent it states why GE did not desire to modify dies.

¶12 not suppressed. Unclear why this is alleged not to be in personal knowledge of Campbell. Moreover, not irrelevant as it goes to Abnet actual reduction to practice.

¶13 not suppressed. Not seen to lack foundation or be based on speculation.

¶14 not suppressed to the extent it describes actions by Campbell and serves to authenticate AX-48-AX-49B.

Affidavit of Duff at AX-9

We are in agreement with the senior party that Fosnaugh has waived objection to this declaration. The affidavit is admitted as within the interest of justice provision of the hearsay exception under Rule 807.

Declarations of Ehler and Fisher were not relied on in the decision. The motion to suppress is considered moot with respect thereto.

Declaration of Grotrian AR39-48

¶¶8, 9 not suppressed. These paragraphs are not seen to lack foundation, be based on hearsay or speculation.

¶12 is suppressed as hearsay

¶13 is not suppressed to the extent that it reflects what Grotrian understood the invention to be.

¶14 not suppressed. Describes action by Grotrian and includes no statement.

¶15 not suppressed. Not seen to lack foundation, constitute hearsay or be based on speculation.

¶16 is suppressed as hearsay.

¶18 not suppressed. Evidence is not suppressed for alleged lack of corroboration. Not irrelevant as giving background of inventive acts.

¶21 suppressed as hearsay.

¶22 suppressed as hearsay

¶25 not suppressed. Concerns action by Grotrian, not hearsay. Verbal go ahead is an action not a statement. Not submitted for the truth of the matter asserted.

¶26 not suppressed. Describes actions of Grotrian. Not hearsay. Unclear how statements are said to lack foundation.

¶¶28-32 not suppressed. Relevant to Abnet reduction to practice.

¶33 not suppressed.

¶¶34-40 suppressed as irrelevant.

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Affidavit of Grotrian (AX-8)

¶¶5-20 not suppressed. Evidence is relevant insofar as Abnet theoretical prediction of no advantage to chevron-shaped bridges is vindicated. Not seen to lack a proper foundation. It is unclear why this material is thought to be outside Grotrian's personal knowledge.

Affidavit of Grotrian at AR92-97

¶6 not suppressed to the extent it is based on personal knowledge.

¶7 not suppressed to the extent that it describes action of Abnet such as sketching.

¶8 not suppressed to the extent it is based on personal knowledge.

¶11 not suppressed as irrelevant. Gives background of inventive acts.

¶12 suppressed as hearsay.

¶¶13-19 not suppressed. This evidence does not lack authentication. Admissible under Rule 1003.

Declaration of Hille (68-70)

The declaration has not been relied upon in the decision and the motion for suppression thereof is moot.

Declaration of Lee (AR64-67)

The declaration has not been relied upon in the decision and the motion for suppression thereof is moot.

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Declaration of Lee (AR103-104)

The declaration has not been relied upon in the decision and the motion for suppression thereof is moot.

Affidavit of McDonald (AX-10)

The declaration has not been relied upon in the decision and the motion for suppression thereof is moot.

Declaration of Neuenschwander (AR34-38)

Not suppressed for lack of knowledge of who prepared declaration. It is immaterial who prepared the declaration as long as the declarant swears that information therein is true.

¶¶2 and 3 not suppressed. It is immaterial who prepared the declaration as long as the declarant swears that information therein is true.

¶¶6-15 not suppressed as irrelevant inasmuch as the evidence includes the background for inventive acts.

¶16 not suppressed. Not hearsay in that witness is stating a technical fact in his own knowledge.

¶17 not suppressed to the extent that it describes acts by witness and Abnet and discusses theoretical opinions of one skilled in the art.

¶18 not suppressed. This evidence appears to be personal knowledge of the witness.

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Affidavit of Neuenschwander (AX-6)

Not suppressed for lack of knowledge of who prepared declaration. It is immaterial who prepared the declaration as long as the declarant swears that information therein is true.

¶¶13, 14 not suppressed as containing details referring to background of inventive acts.

¶¶15, 16 not suppressed as lacking foundation. Conclusory evidence is admissible but may be entitled to little weight.

¶¶17 and 18 not suppressed to the extent that witness is expert in stamping art and can testify to what is well known and standard terminology.

Declaration of Neuenschwander (AR90-91)

Not suppressed for lack of knowledge of who prepared declaration. It is immaterial who prepared the declaration as long as the declarant swears that information therein is true.

¶1 not suppressed to the extent that it reflects witness' personal knowledge.

¶2 not suppressed as showing background of invention in industry.

¶3 not suppressed as stating the provenance of the strips.

Declarations of Niewyk

No declarations by the witness have been relied upon in the decision and the motion for suppression thereof is moot.

Abnet Exhibits

AX-1, see above.

AX-3 not suppressed. Evidence is not suppressed for alleged lack of corroboration.

AX-4 not relied upon. Motion to suppress is moot.

AX-6, see above.

AX-7, see above.

AX-9, see above.

AX-10 not relied upon. Motion to suppress is moot.

AX-11 not relied upon. Motion to suppress is moot.

AX-12 not relied upon. Motion to suppress is moot.

AX-13, 14, and 15, see above.

AX-16 not relied upon. Motion to suppress is moot.

AX-17 not relied upon. Motion to suppress is moot.

AX-18 not relied upon. Motion to suppress is moot.

AX-19 not relied upon. Motion to suppress is moot.

AX-20 not relied upon. Motion to suppress is moot.

AX-30 not relied upon. Motion to suppress is moot.

AX-31 not relied upon. Motion to suppress is moot.

AX-32 not relied upon. Motion to suppress is moot.

AX-34 not relied upon. Motion to suppress is moot.

AX-39 not suppressed. See above.

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AX-48-49B not suppressed. See above.

AX-50 not suppressed as background material related to inventive acts.

AX-53 not suppressed. See decision. Recreated sketches entitled to but little weight.

AX-54-59 not relied upon. Motion to suppress is moot.

AX-61-67 not relied upon. Motion to suppress is moot.

AX-72-75 not relied upon. Motion to suppress is moot.

AX-91-96 not relied upon. Motion to suppress is moot.

Abnet Motion to Suppress

The motion to suppress evidence relating to Claim 27 is **DENIED**. This includes the specific testimony, affidavits, declarations and other materials listed on pages 6 and 7 of Abnet's motion. In the interest of completeness, the panel has considered this issue even though claim 27 has already been declared unpatentable to party Abnet.

The motion to suppress evidentiary material relating to the withdrawn motions of party Fosnaugh is **GRANTED**. To the extent that the named exhibits, declarations and depositions run to the withdrawn motions, they will not be considered by the panel. This material is, of course, available in other proceeding in the USPTO.

The motion to suppress certain evidence of Fosnaugh under Rule 1002 is **DENIED** for the reasons given in the opposition at pages 9 and 10.

Specific paragraphs itemized in Abnet's motion:

¶12 not suppressed. The material is relevant as background to inventive acts by Fosnaugh and will not be suppressed for irrelevance. Material is not suppressed for lack of corroboration--corroboration is not an admissibility issue.

¶13 not suppressed. The material in question is relevant as background to inventive acts.

¶14 not suppressed. The material in question is relevant as background to inventive acts.

¶15 not suppressed. The material in question is relevant as background to inventive acts.

¶20 not suppressed to the extent it describes acts of Grotrian.

¶22-25 not suppressed. Material is not suppressed for lack of corroboration--corroboration is not an admissibility issue.

¶38 not relied upon. Motion to suppress dismissed as moot.

¶74 not relied upon. Motion to suppress dismissed as moot.